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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/449,066	05/24/95	DIEHL	H X-

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12M2/0129

CRIAREEXAMINER	
ART UNIT	PAPER NUMBER
1205	7

DATE MAILED:

01/29/96

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.

08/449,066

Applicant(s)

Diehl

Examiner

T.J. Criares

Group Art Unit

1205



☒ Responsive to communication(s) filed on Dec 22, 1995

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1 and 3-6 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 and 3-6 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. Applicant's arguments filed December 22, 1995 have been fully considered but they are not deemed to be persuasive.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1 and 3-6 are again rejected under 35 U.S.C. § 103 as being unpatentable over Diehl in view of The Merck Manual. As previously stated Diehl teaches the use of applicant's claimed active agent to treat and prevent the formation of poly-arthritis. Applicant argues that osteoarthritis, as presently claimed, is a result of "wear and tear on the joints" and that osteoarthritis does not involve inflammation. However, the Merck Manual reference teaches at page 1341 that drugs commonly used for the treatment of rheumatoid arthritis are also used in the treatment of osteoarthritis. In view of this teaching the skilled artisan would have been motivated to use applicant's claimed active agent in the treatment of osteoarthritis with a reasonable expectation of success to relieve the symptoms of osteoarthritis. The skilled artisan would have been motivated to use applicant's claimed active agent to treat osteoarthritis with a reasonable expectation of success since Diehl teaches that it has polyarthritic activity.

The amounts of active agents to be used and the mode of administration (claims 3-6) are deemed obvious since they are all within the knowledge of the skilled pharmacologist and represent conventional formulations and modes of administration.

Serial Number: 08/449,066
Art Unit: 1205

-3-

The applicant's data has been reviewed but is deemed to corroborate the findings in the Diehl reference.

A prima facie case of obviousness under 35 U.S.C. § 103 has been present and the rejection of claims 1 and 3-6 is deemed proper.


4. None of the claims are allowed.

5. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Criares whose telephone number is (703) 308-4607.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.


THEODORE J. CRIARES
PRIMARY
GROUP